

REMARKS

Claims 1 – 5 are pending in the instant patent application. Independent claims 1 and 5 have been amended to more clearly and distinctly claim the subject matter which Applicants regards as their invention. Support of the amendments to claims 1 and 5 may be found, for example, at paragraphs 0025 and 0026 of Applicants' published application.

Claims 1 – 2 and 4 are rejected under 35 U.S.C. § 103 as being unpatentable over eSpeed (eSpeed Signs Deals with 7 Online Brokers to Give Consumers the Ability to Trade Bonds the Same Way They Trade Stocks. PR Newswire. New York, May 15, 2000, p.1) in view of ClearCHOICE (BNY ESI & Co. Launches ClearCHOICE (SM). PR Newswire. New York. October 5, 1998. p.1). The Office Action asserts that eSpeed discloses a first computer, a second computer for performing middle and back office processing, a communication channel for communicating between the first and second computers, where the first computer is a client computer and where the communication channel is the Internet, and the interface is a browser. The Office Action admits that eSpeed does not disclose a first computer having an interface for capturing executed trade data, a second computer for accepting the captured trade data, or a communication channel for communicating the captured trade data between the first and second computers. The Office Action admits that ClearCHOICE does not describe "a computer having an interface for capturing trade data" but discloses a computer system "efficiently capturing trade data," which would require a computer having an interface for entering/inputting the captured trade data.

Claim 5 is rejected under 35 U.S.C. § 103 as being unpatentable over eSpeed in view of Richards (US Patent 5,003,473). The Office Action asserts that Richards teaches a first computer having an interface transmitting electronic trade tickets and a second computer for receiving the electronic trade tickets.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. 2143.03 citing *In re Royka*, 490 F.2d 981 (CCPA 1974). Rejections on obviousness grounds cannot be sustained by mere conclusory statements but must be supported by some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). A finding of obviousness under 35 U.S.C. § 103(a) requires a determination that the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. Deere*, 383 U.S. 1 (1966). The relevant inquiry is whether the prior art suggests the invention and whether the prior art provides one of ordinary skill in the art with a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be found in the prior art. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Regarding the rejection of independent claim 1, Applicants respectfully disagree with the Office Action's assertion that "efficiently capturing trade data" requires a computer having an interface for entering/inputting the captured trade data. In asserting that "efficiently capturing trade data" inherently requires a computer having an interface for entering/inputting the captured trade data, there can be no other method of efficiently capturing the trade data. See MPEP §2112. Both eSpeed and ClearCHOICE teach a Straight-Through-Processing (STP) system that integrates trade order, execution, and settlement. Both systems can efficiently capture trade data by intercepting the trade data directly from the exchange where the trade was executed. This does not require a first computer to enter/input the data. Therefore, ClearCHOICE does not inherently disclose "a first computer having an interface for capturing executed trade data" because trade data may be captured without a first computer having an interface for capturing executed trade data.

Applicants respectfully disagree with the assertion that eSpeed or ClearCHOICE contain a motivation to combine the references. In contrast, Applicants submit that

eSpeed and ClearCHOICE actually teach away from the claimed invention. Both references describe integrated systems that provide STP for trades executed within their systems. See, for example, ClearCHOICE statement, "efficiently capturing trade data within our straight-through processing system." Unlike the cited references, Applicants' claimed invention allows access to middle and back office processing of trades that were executed on another system. This capability allows outsourcing of the middle and back office processing for users of the system. Neither eSpeed nor ClearCHOICE teach or suggest handling trade data that were not executed on their system and teach away from such use by disclosing only processes within their systems.

Applicants respectfully submit that the combination of eSpeed with ClearCHOICE does not teach every claim limitation of independent claim 1 nor do they suggest a motivation to combine the references. Applicants submit that a *prima facie* case for obviousness has not been made. Furthermore, claims 2 – 4 depend on independent claim 1 and include all the limitations of claim 1. Applicants submit that claims 2 – 4 are in condition of allowance because claim 1 is allowable.

The amendments to claim 5 obviate the rejection of claim 5. Applicants submit that neither cited reference teaches, suggest or motivates one of ordinary skill in the art to modify and combine the references. Specifically, neither eSpeed nor Richards, as the Office Action admits, teach a second computer receiving the electronic tickets from the client computer. Furthermore, eSpeed teaches away from the claimed invention by providing only single broker integrated services. The ability to receive electronic trade tickets from the client computer for trades executed by another broker is not taught by eSpeed and is implicitly discouraged.

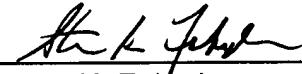
Applicants respectfully submit that the rejections of claims 1 – 5 under 35 U.S.C. § 103 have been overcome. Applicants respectfully request that the rejections be withdrawn.

Applicants request entry of the foregoing amendments and remarks into the file history of the above-identified application. Applicants believe that each ground for rejection has been successfully overcome and/or obviated, and that all pending claims are in condition for allowance. Withdrawal of the rejections and allowance of the application are respectfully requested.

No additional fee is believed to be due in connection with filing of the instant request. However, if a fee is due, please charge the required fee to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310.

Respectfully submitted,

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